

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, **the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions.** In such a case, the examiner will not follow the procedure described below and will not require restriction. Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), **it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention.** In *re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). **Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.**

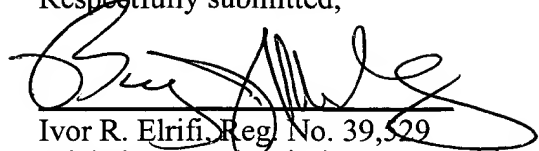
The claimed peptides of the present invention are not individually distinct and independent, but are, in fact, **members of the same superfamily of proteins**, the “morphogens.” Markush claims 23 and 24 recite these proteins. As described in the Specification, these morphogens (1) are generally understood to refer to a protein which can induce the full cascade of morphogenic events culminating in new organ-specified tissue formation; and (2) share a conserved seven cysteine residues and high degree of homology with the first 102 amino acid of the mature OP-1, an essential feature for morphogen activity. *See*, Specification at pages 7, line 14 - page 8, line 8; page 12, lines 1-20; and page 23, line 19 - page 24, line 12. Accordingly, since morphogens (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility, Applicants respectfully submit that unity of invention exists for the morphogens included within the Markush group of the claims of the present application, and request withdrawal of this election requirement.

CONCLUSION

On the basis of the foregoing remarks, Applicants respectfully request the withdrawal or modification of the present election requirement under 37 C.F.R. §1.143. Should there be any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Applicants: Sampath *et al.*
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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Ivor R. Elrifi', is written over a horizontal line.

Ivor R. Elrifi, Reg. No. 39,529
Michel Morency, Limited Recognition
Barry J. Marenberg, Reg. No. 40,715
Attorneys for Applicants
c/o MINTZ, LEVIN
One Financial Center
Boston, Massachusetts 02111
Tel: (617) 542-6000
Fax: (617) 542-2241

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